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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,284	12/02/2003	Robin Pou	14706-002001	5291

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EXAMINER
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WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3685

NOTIFICATION DATE	DELIVERY MODE
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10/08/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,284	<b>Applicant(s)</b> POU ET AL.	
	<b>Examiner</b> JOHN M. WINTER	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19,49-54,60-62,74-84,100-103 and 108-112 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,49-54,60-62,74-84,100-103 and 108-112 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicants amendment filed on July 7, 2008 is hereby acknowledged.  
Claims 1-19, 49-54, 60-62, 74-84, 100-103 and 108-112 remain pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to the amended claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19, 49-54, 60-62, 74-84, 100-103 and 108-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boebert et al (U.S. Patent 6,044,469) in view of Downs et al. and further in view of William (US Patent 4740890).

5. As per claim 1,  
Boebert ('946) discloses a method for managing digital rights, the method comprising:  
detecting a data file on a user device, wherein the data file includes a digital wrapper preventing access to the data file without a valid authorization; disabling the digital wrapper based on

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authorization. (Discussion of “keying of devices – at Column 12, line 17 – column 13, line 19) Boebert ('946) does not explicitly disclose searching for information relating to an authorization to access the data file using data stored in a non-volatile storage area of the user device; Downs et al ('618) discloses searching for information relating to an authorization to access the data file using data stored in a non-volatile storage area of the user device; (Column 21, line 64- column 22, line 8) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Boebert ('946) system with the Downs et al ('618) system in order to hide the access key from casual observation.

Boebert ('946) does not explicitly disclose identify information relating to an authorization to access the data file; and determining whether the user device includes software for disabling the digital wrapper, with the determination being made using executable instructions associated with the digital wrapper; William ('890) discloses identify information relating to an authorization to access the data file; and determining whether the user device includes software for disabling the digital wrapper, with the determination being made using executable instructions associated with the digital wrapper; (Abstract – Column 4, line 59, Column 5, line 2 [Examiner notes that the operating system of the user computer would inherently associate the disclosed module with the process for unlocking the media, and in doing so would the user computer necessarily “determines” if software is available on the computer for disabling the digital wrapper ]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Boebert ('946) system with the William ('890) system in order to hide the access key from casual observation.

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Claims 49, 60, 74, 100, 108 are not patentably distinct from claim 1 and are rejected for at least the same reasons

6. As per claim 2,

Boebert ('946) discloses the method of claim 1

wherein the data file comprises a media file.(Abstract )

7. As per claim 3,

Boebert ('946) discloses the method of claim 1

Boebert ('946) does not explicitly disclose wherein the search for information relating to an authorization to access the data file is conducted in a license database on the user device.

Downs et al ('618) discloses wherein the search for information relating to an authorization to access the data file is conducted in a license database on the user device.; (Column 21, line 64-column 22, line 8) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Boebert ('946) system with the Downs et al ('618) system in order to hide the access key from casual observation.

8. As per claims 4-6,

Boebert ('946) discloses the method of claim 3

Official Notice is taken that "wherein the license database is located in the non-volatile storage area of the user device; wherein the non-volatile storage area of the user device comprises a basic input/output system (BIOS); wherein the data stored in the non-volatile storage area of the

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user device includes a location of the license database” is common and well known in prior art in reference to licensing protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a secure memory area such as a BIOS to store a table of licenses in order to create a robust system for controlling access to content or services.

9. As per claim 7,

Boebert ('946) discloses the method of claim 3

wherein the data stored in the non-volatile storage area of the user device includes an access key for the license database, with the access key being necessary to access the license database.

(Discussion of “keying of devices – at Column 12, line 17 – column 13, line 19)

10. As per claim 8,

Boebert ('946) discloses the method of claim 3

wherein the license database includes an access key for the data file, with the access key being necessary to disable the wrapper. (Discussion of “keying of devices – at Column 12, line 17 –

column 13, line 19)

11. As per claim 9,

Boebert ('946) discloses the method of claim 1

wherein the search for information relating to an authorization to access the data file is conducted in a license database associated with a remote server. (Discussion of “keying of devices – at Column 12,line 17 – column 13, line 19)

12. As per claim 10,

Boebert ('946) discloses the method of claim 9

wherein the search for information relating to an authorization to access the data file is conducted in the license database associated with the remote server in response to a determination that a local database on the user device does not include information relating to an authorization to access the data file. (Discussion of “keying of devices – at Column 12,line 17 – column 13, line 19)

13. As per claim 11,

Boebert ('946) discloses the method of claim 9

further comprising sending identification data for the user device to the central server, wherein the identification data is adapted to allow the central server to validate the user device.

(Discussion of “keying of devices – at Column 12,line 17 – column 13, line 19)

14. As per claim 12,

Boebert ('946) discloses the method of claim 11

wherein the identification data includes a digital key associated with at least one of: the user device; and-or a user associated with the user device. (Discussion of “keying of devices – at

Column 12,line 17 – column 13, line 19)

15. As per claim 13,

Boebert ('946) discloses the method of claim 1

Official Notice is taken that “offering for purchase an authorization to access the data file; receiving an acceptance of the offer to purchase; and disabling the digital wrapper in response to the acceptance of the offer” is common and well known in prior art in reference to licensing protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to sell authorization to use content in order to recoup the expense of producing the content.

16. As per claim 14

Boebert ('946) discloses the method of claim 13 further comprising:

sending the acceptance of the offer to a central server; receiving a message from the central server in response to the acceptance of the offer, wherein data contained in the message is used to disable the digital wrapper. (Discussion of “keying of devices – at Column 12,line 17 – column 13, line 19)

17. As per claim 15

Boebert ('946) discloses the method of claim 14



further comprising sending identification data for the user device to the central server, wherein the identification data is adapted to allow the central server to validate the user device. (Figure 15 –element 24 “security server” is equivalent to central server)

18. As per claim 16

Boebert ('946) discloses the method of claim 15

wherein the identification data includes a digital key associated with at least one of the user device and for a user associated with the user device. (Column 10, line 30 – the PIN number of the personal keying device)

19. As per claim 17,

Boebert ('946) discloses the method of claim 13

further comprising storing information relating to an authorization to access the data file on the user device. (Column 9, line 34 – usage of the personal keying device)

20. As per claim 18,

Boebert ('946) discloses the method of claim 1

further comprising denying access to the data file if an authorization to access the data file is not found during the search and if an offer to purchase an authorization to access the data file is not accepted. (Figure 33 )

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: “Language that suggest or

makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

21. As per claim 19,  
Boebert ('946) discloses the method of claim 1  
wherein searching for information relating to an authorization to access the data file comprises determining whether the user device includes software for disabling the digital wrapper, with the determination being made using executable instructions stored in the digital wrapper.  
(Figure 33 )
22. Claims 50-54, 61-62, 75-84, 101-103 and 109-112 disclose the same invention as claims 1-19, because these claims are not patentably distinct from claims 1-19 they are rejected for at least the same reasons.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter

Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685